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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/213,169	12/17/1998	JOHN R. FREDLUND	78685F-P	7343

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PATENT LEGAL STAFF
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EXAMINER
FRIDIE JR, WILLMON

ART UNIT	PAPER NUMBER
3722	17

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/213,169	Fredlund
Examiner	**Art Unit**
Willmon Fridie	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 2, 2003* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-36 and 40-63* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-36 and 40-63* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1,7,12,13,19,23-25,29,34,35,40,43,44,46,50-52,57,58,62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al. ('692) in view of Shiota..

Manico et al. Discloses an album leaf comprising a plurality of images (15-19 and 21-25), first and second sides (12,14) having a retaining means for holding the memory images and a

plurality of openings (28). Manico et al lacks the disclosure of first and second icons for identifying first and second sources of the memory images on the photographic sheets. Shiota discloses a photographic sheet comprising an icon (64) with an image ID (65) inside the silhouette (60a,61a). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. With an identifying icon with identification numbers which correspond to the images on the album leaf as taught by Shiota in order to categorize the content and provide more information on the images. To provide a second icon would have been obvious to a skilled artisan, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V Bemis Co.*, 193USPQ8.

4. Claims 2-6,14-18,26-28,30,36,41-45 and 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico in view of Shiota as applied to claims above, and further in view of Manico et al.('870).

Manico et al. As modified by Shiota discloses the claimed invention except for an origination ID being associated with at least one of the plurality of images which indicates the first source. Manico et al.('870) teaches that it is well known in the art to use a photographic sheet comprising an origination ID.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. As modified by Shiota with an origination ID inside the silhouette as taught Manico et al ('870) to indicate the identification images and the location of the images on the photographic sheet.

5. Claims 8,20,31,37 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico('692) in view of Shiota as applied to claims above, and further in view of Werner.

Manico('692) as modified by Shiota discloses the claimed invention except for a film cartridge containing a strip of photographic film wherein the cartridge has an ID number. Werner teaches that it is well known in the art to use an apparatus for storing a film cartridge (23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico('692) as modified by Shiota with a film cartridge on a photographic sheet in the manner as taught by Werner et al. So that the film cartridge can be kept together with corresponding images for later use. Further, Official Notice is taken of the use of ID numbers on a film cartridge. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use ID numbers on a film cartridge since the use of such is old and well known in the art.

6. Claims 9/10/21/22/32/33/48/49/60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico ('692) in view of Shiota as applied to claims above, and further in view of Combs.

Combs discloses a CD ROM holder comprising a CD ROM (10) on the photographic sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico ('692) as modified by Shiota with a CD Rom and holder in order to increase the storage capacity of the assembly. Further, Official Notice is taken of the use of ID numbers on a CD ROM holder. It would have been obvious to one having ordinary skill in the art

at the time the invention was made to use ID numbers on a CD ROM holder since the use of such is old and well known in the art.

Response to Arguments

7. Applicant's arguments filed 4/2/03 have been fully considered but they are not persuasive. .

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument that Manico et al. ('692) and Shiota is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

In order to reduce pendency and avoid potential delays, Group 3700 is encouraging FAXing of responses to Office actions directly into the Group...***Official- (703)872-9302...After Final-(703) 872 9303***. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

Any inquiries concerning issues other than the substantive content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative,Tech Center 3700, (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 308-1148.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. Fridie, jr. whose telephone number is (703) 308-1866.

wf

June 30, 2003

WILLMON FRIDIE, JR.
PRIMARY EXAMINER